

REMARKS

By the above amendment, informalities in the specification have been corrected, claim 31 has been canceled without prejudice or disclaimer of the subject matter thereof and the remaining claims have been amended to clarify features thereof, as will be discussed below.

As to the provisional rejection of claims 29 - 38 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28 - 30 and 38 - 39 of copending Application No. 09/986,229 in view of Gallarda et al (USPN 6,539,106), applicants note that the rejection is provisional in that claims of the copending application have not been allowed. However, without acquiescing in the propriety of the rejection, in order to eliminate such provisional rejection at this time, submitted herewith is a Terminal Disclaimer and the appropriate statutory fee therefor, so that as recognized by the Examiner, this rejection should now be overcome.

As to the rejection of claims 28 - 38 under 35 USC 102(e) as being anticipated by Gallarda et al (USPN 6,539,106), this rejection is traversed insofar as it is applicable to the present claims and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 USC 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To

establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

By the present amendment, the claims have been amended to clarify and recite features of the present invention as described in paragraphs [0027] - [0031], for example, in which a mask region 42, as illustrated in Fig. 7 is inputted for display on the display as shown in Figs. 6 and 7 of the drawings of this application, for example, wherein the image display part 56 displays an actual image of a defect and the map display part 55 displays a map of locations of defects on the object substrate as well as a mask region in which defects are not to be detected. As described in connection with Fig. 14, for example at paragraphs [0066], et. seq. a mouse operation command button and a mouse are utilized for inputting information concerning the mask region 42 for display on the display means and in accordance therewith, defects appearing in the mask region are not detected and extracted. By the present amendment, the aforementioned features have been recited in each of the independent and therewith the dependent claims of this application. For example, referring to claim 28, this claim has been amended to recite a display having a screen on which the digital image of the object substrate is displayable, an input device for inputting information of a non-inspection region to be masked on the object substrate for display on the screen in addition to the previously recited features including an image detecting part, a memory part and a defect judging part and now recites the feature of "wherein an actual digital image of the detected defect

is displayed together with positional information of the detected defect in a map form on the screen of the display". That is, referring to Figs. 13 and 14, the current position indicator 59 is placed over one of the symbols of the pattern defects 11 representing display in a map format in which the mask region 42 is also displayable in the image display part 55 of the screen and an actual image of the defect on which the current position indicator 59 is placed is displayed in the image display part 56, as described in the specification of this application. The other independent claims have been amended in a substantially similar manner and applicants submit that such features are not disclosed or taught in the cited art as will become clear from the following comments.

Irrespective of the Examiner's contentions concerning Gallarda et al, and the Examiner's contention that this patent discloses a display having the screen on which a digital image of the detected defect is displayed together with positional information of the detected defect in a map form referring to Fig. 3 and numeral 345, applicants submit that Gallarda et al does not disclose or teach an input device for inputting information of a non-inspection region to be masked on the object substrate for display on the screen, as recited in claim 28, and the similar features as recited in the other claims of this application, nor the feature that an actual digital image of the detected defect is displayed together with positional information of the detected defect in map form on the screen of the display. That is, column 6, lines 32 - 35 of Gallarda et al indicates that at step 345, intermediate images and results, such as a map of defects and statistics about defect location, size, type, etc. are optically displayed for monitoring by a human operator on a display screen 350. Applicants submit that such display as described in Gallarda et al is not a display of an actual digital image of the detected defect which, in accordance with the present invention,

is displayed on the image display part 56 of the screen of the display as shown in Fig. 13 of the drawings of this application, and which is displayed together with positional information of the detected defect in a map form on the map display part 55 of the screen of the display. Irrespective of the contentions by the Examiner, Gallarda et al does not disclose or teach such features in the sense of 35 USC 102 or 35 USC 103. Further, as pointed out above, there is no disclosure or teaching in Gallarda et al of an input device for inputting information of a non-inspection region to be masked on the object substrate for display on the screen, as recited in the independent claims of this application. Thus, applicants submit that all claims present in this application, i.e., claims 28 - 30 and 32 - 38 patentably distinguish over Gallarda et al in the sense of 35 USC 102 and 35 USC 103 and should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit that all claims patentably distinguish over the cited art and should now be in condition for allowance noting that the provisional obviousness-type double patenting rejection has been overcome by the submission of a Terminal Disclaimer. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli,

Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 501.40830VX1),
and please credit any excess fees to such deposit account.

Respectfully submitted,

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